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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,751

10/04/2006

Roger Picano

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EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

04/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/572,751	Applicant(s) PICANO ET AL.	
	Examiner COURTNEY BROWN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/09/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt/Status of Claims

This Office Action is in response to the amendment filed January 26, 2009. Claims 12-31 are pending. Claims 1-11 stand cancelled. Claims 12-31 are being examined for patentability.

Applicant's arguments, filed January 26, 2009, with respect to the rejection(s) of claim(s) 12-31 under 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection has been made below.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

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Priority

Priority to German Foreign Applications 10344166.2 filed on September 22, 2003 is acknowledged.

Information Disclosure Statement

The Information Disclosure Statements (IDS) submitted on January 22, 2008 has been considered by the examiner.

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The information disclosure statement filed November 9, 2007 **fails to comply with 37 CFR 1.98(a)(3)** because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560) and Albacarys et al. (US Patent 6,338,855 B1) in view of Golz-Berner et al. (US Patent 6,989,150 B1)

Applicant's Invention

Applicant claims a cosmetic preparation comprising (a) a protein hydrolyzate from at least one of silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional.

Determination of the scope and the content of the prior art (MPEP 2141.01)

Yasuda et al. teach a hairdye composition containing (A) 0.001-20 (esp. 0.01-5)wt.% of protein hydrolyzate(s) such as keratin protein hydrolyzate(s), collagen protein

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hydrolyzate(s), silk protein hydrolyzate(s) or elastin protein hydrolyzate(s) and (B) 0.001-20 (esp. 0.01-5)wt.% of amino acid(s) (derivative(s)) such as glycine, (phenyl)alanine, valine, leucine, serine, threonine, tyrosine, asparagine (aspartic acid), cysteine, histidine, arginine, glutamine, pyrrolidonecarboxylic acid and salt(s) thereof (abstract, claims 12,15-17,21,22-24,28-31 of instant application).

Albacarys et al. teach a personal cleansing article useful for both cleansing the skin or hair and delivering skin care actives onto the skin or hair (abstract). Albacarys et al. teach the use of amino acids (column 17, lines 5-27 and column 19, lines 25-38); taurine (column 20, line 45, claims 13 and 14 of instant application); hydrolyzed collagen, elastin, keratin, and silk (column 32, lines 28-47); sericin (column 42, line 44); and antioxidants (column 46, line 59, claim 18 of instant application). Albacarys et al. also teach a method of cleansing and treating the skin or hair with the aforementioned personal cleansing article (column 50, lines 45-49, claim 28 and 31 of the instant application). Additionally, Albacarys et al. teach that the conditioning component of the aforementioned cleansing article can comprise a conditioning emulsion (column 38, lines 31-34, claim 26 of instant application).

***Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Yasuda et al. and Albacarys et al. is that the instant invention requires the use of an extract from mussel threads of mussels. For this reason, the teaching of Golz-Berner et

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al. is joined. Golz-Berner et al. teach the use of extracts of byssus (mussel silk) in a cosmetic preparation (see claim 8 of Golz-Berner et al.).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the cited references to arrive at a cosmetic preparation for the hair comprising silk, pashmina, cashmere wool, merino wool and mohair, (b) an extract from mussel threads of mussels, (c) at least one of sericin and a hydrolyzate of sericin, and (d) optionally, one or more amino acids which are at least one of biogenic and functional. One would have been motivated to make this combination in order to receive the expected benefit of having a composition that as a source of a biotechnological protein (see claim 8 of Golz-Berner et al.) "It would be prima facie obvious to combine compositions each of which is taught by the prior art to be useful for the same purpose in order to form a resultant composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art." In re Kerkhoven, 205 USPQ 1069 (C.C.P.A. 1980).

Although the aforementioned references do not teach the specific antioxidant percentage as claimed in the instant application, absent a showing of unexpected results, it would be obvious to one of ordinary skill in the art to vary the percentage amounts depending on the desired result. Determining optimal percentage of cosmetic

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personal care components is routine experimentation and is readily practiced by one of ordinary skill.

Response to Arguments

Applicant's arguments, filed January 26, 2009 with respect to the 103 rejection of claims 12-31 under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (JP 330560) and Albacarys et al. in view of European Cosmetic Markets (The Magic of Molluscs, February 2004) have been considered but are moot in view of the new ground(s) of rejection.

The claims remain rejected.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown
Patent Examiner
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/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616